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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,613	11/02/2001	Lawrence P. Shields	74622-020	6203
21890 7590 01/05/2007 PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/003,613

Applicant(s)

SHIELDS ET AL.

Examiner

Sara Chandler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/20/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 35-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/23/02
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of invention I claims 1-21 and 35-44 in the reply filed on 11/20/06 is acknowledged.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains legal phraseology such as comprises and means for. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 and 35-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 1-21 and 35-44: The preamble of independent claims 1,2 and 21 recites the systems and methods are for implementing at least one employee stock plan however, the claimed invention fails to do this. Dependent claims 3-20 and 35-44 are rejected under the same rationale.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 21** is rejected under 35 U.S.C. 102(e) as being anticipated by Cristofich, US Pat. No. 6,269,346.

**Re Claim 21:** Cristofich discloses a method for implementing at least one employee stock plan, comprising:  
processing a transaction pursuant to the employee stock plan via a computer implemented finance system (Cristofich, abstract, col. 1, lines 13-19; col. 1, lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12, line 25-62);

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storing participant information in volatile data storage pursuant to a data transfer from a nonvolatile database of a third party administration system (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13); interacting with a participant regarding a requested transaction, and enabling the participant to select a response pertaining to the employee stock plan (Cristofich, abstract, col. 1, lines 20-col.2, lines 28; col. 2, lines 40-48; col. 2, lines 55+- col. 3, lines 7; col. 3, lines 30-48; col. 4, lines 10-34; col.5, lines 58 – col. 6, line 3; col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8, lines 38+ - col.46, line 8; col. 9, lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12, line 13; col. 12, line 25+- col. 14, line 5); conducting the participant transaction on a public exchange via a trading system (Cristofich, abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4, line 10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines 18; col. 10, lines 1+ - col. 14, line 5); updating the participant information in the volatile data storage according to the selections and transactions made by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12, lines 63+ - col. 14, line 5)); and enabling a corporate employer to run a report based on the participant information pursuant to a reporting system (Cristofich, col. 10, lines 1-11; col. 10, lines 60+ -col. 11, lines 45; col. 12, lines 14-24).

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-20 and 35-44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristofich, US Pat. No. 6,269,346 in view of Garman, US Pat. No. 5,692,233.

**Re Claims 1, 1/3, 1/11 - 1/20, 1/35 - 1/44:** Cristofich discloses a system for implementing at least one employee stock plan comprising:  
a computer-implemented finance system for processing a transaction pursuant to the employee stock plan (Cristofich, abstract, col. 1, lines 13-19; col. 1, lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12, line 25-62), the finance system including:

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a volatile data storage for storing participant information pursuant to a data transfer from a nonvolatile database of a third party administration system (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13) ; interacting with a participant regarding requested transactions and enabling the participant to select a response pertaining to the employee stock plan (Cristofich, abstract, col. 1, lines 20-col.2, lines 28; col. 2, lines 40-48; col. 2, lines 55+- col. 3, lines 7; col. 3, lines 30-48; col. 4, lines 10-34; col.5, lines 58 – col. 6, line 3; col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8, lines 38+ - col.46, line 8; col. 9, lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12, line 13; col. 12, line 25+- col. 14, line 5); a trading system for conducting individual participant transactions on a public exchange (Cristofich, abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4, line 10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines 18; col. 10, lines 1+ - col. 14, line 5); a communication system that connects the participant to the finance system (Cristofich, abstract, col. 3, lines 49-65; col. 4, lines 10-34; col. 7, lines 53+ - col. 8, lines 18; col. 11, lines 8+ - col. 12, line 13; col. 12, line 25+ - col. 14, line 5); and means for updating the participant information in the volatile data storage according to the selections and transactions made by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12, lines 63+ - col. 14, line 5)).

Cristofich fails to explicitly disclose an interface system.

Garman discloses an interface system (Garman, abstract, Figs. 4a,4b; col. 3, lines 54+ - col. 4, line 30; col. 6, line 47+ - col. 7, line 16; col. 8, lines 18-38).

Intended Use: The claims make several intended use statements which do not carry patentable weight (i.e., "a system for"; "computer-implemented finance system for"; "a volatile data storage for"; "an interface system for"; "a trading system for"; "means for"). What follows the statement of intended use (i.e., "for") does not carry patentable weight. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Cristofich by adopting the teachings of Garman to provide a system further comprising an interface system for interacting with a participant regarding requested transactions and enabling the participant to select a response pertaining to the employee stock plan.

One would have been motivated to provide a convenient and easily usable tool for users to interact with and manipulate the system.

**Re Claims 2, 2/3 – 2/20, 2/35 – 2/44:** Cristofich discloses a system for implementing at least one employee stock plan comprising:  
a computer-implemented finance system for processing a transaction pursuant to the employee stock plan (Cristofich, abstract, col. 1, lines 13-19; col. 1, lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col. 4, line



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33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12, line 25-62), the system including:

a volatile data storage for storing participant information pursuant to a data transfer from a non-volatile database of a third party administration (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13); interacting with a participant regarding requested transactions, and for enabling the participant to make selections regarding their respective employee stock plans (Cristofich, abstract, col. 1, lines 20-col.2, lines 28; col. 2, lines 40-48; col. 2, lines 55+- col. 3, lines 7; col. 3, lines 30-48; col. 4, lines 10-34; col.5, lines 58 – col. 6, line 3; col. 6, lines 17-26; col. 7, line 60+ - col. 8, line 18; col. 8, lines 38+ - col.46, line 8; col. 9, lines 20-58; col. 10 lines 1-33; col. 11, lines 8+- col. 12, line 13; col. 12, line 25+- col. 14, line 5);

a trading system for conducting individual participant transactions on a public exchange (Cristofich, abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4, line 10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines 18; col. 10, lines 1+ - col. 14, line 5);

a communication system that connects the participant to the system (Cristofich, abstract, col. 3, lines 49-65; col. 4, lines 10-34; col. 7, lines 53+ - col. 8, lines 18; col. 11, lines 8+ - col. 12, line 13; col. 12, line 25+ - col. 14, line 5);

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means for updating the participant information in the volatile data storage according to the selections and transactions made by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12, lines 63+ - col. 14, line 5)); and

a reporting system that enables a corporate employee to run a report based on the participant information (Cristofich, col. 10, lines 1-11; col. 10, lines 60+ -col. 11, lines 45; col. 12, lines 14-24).

Cristofich fails to explicitly disclose an interface system.

Garman discloses an interface system (Garman, abstract, Figs. 4a,4b; col. 3, lines 54+ - col. 4, line 30; col. 6, line 47+ - col. 7, line 16; col. 8, lines 18-38).

Intended Use: The claims make several intended use statements which do not carry patentable weight (i.e., "a system for"; "computer-implemented finance system for"; "a volatile data storage"; "an interface system for"; "a trading system for"; "means for"). What follows the statement of intended use (i.e., "for") does not carry patentable weight. The claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify an interface system for interacting with a participant regarding requested transactions, and for enabling the participant to make selections regarding their respective employee stock plans.

One would have been motivated to provide a convenient and easily usable tool for users to interact with and manipulate the system.

Broadest Reasonable Interpretation: The following terms have been given their broadest reasonable interpretation for purposes of the examination of pending claims 1-21 and 35-44 (See MPEP § 2111 [R-5]):

- Transaction- any agreement, deal or exchange between parties.
- Volatile data storage- is memory that requires power to maintain the stored information.
- Non-volatile database- is a collection of information or records that can be retained and stored even when not powered via secondary storage, or long-term persistent storage means.
- Participant- any person that participates, shares or takes part.
- Third party Administration System- a system capable of the duty or duties of an administrator with respect to a business or operation.
- Communications System- a system capable of providing information transfer between persons and equipment.
- Interface System- is a system capable of providing the point of interaction or communication between a computer system and any other entity, such as a printer or human operator.
- Trading System- a system capable of allowing parties to engage in buying, selling and/or bartering.

- Reporting System- a system capable of providing an account or statement regarding the details of an event, situation or transaction.
- Public Exchange- a place where things, such as securities and commodities, are bought and sold.
- Employee stock plan- any plan related to the rights or privileges held by an employee with respect to stock or ownership shares in a corporation.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

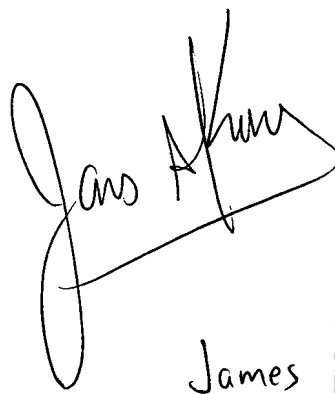
Bell, US Pat. No. 6,161,096- stock options.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

  
12/21/06  
James Kramer